

REMARKS**Prior Restriction Requirement**

In the restriction requirement dated February 19, 2004, the Examiner restricted the claims between three groups. Group I included claims 1-41 and 48-50, group II included claims 42-47, and group III included claims 51-55. In response to the restriction requirement, Applicants elected group I without traverse. In this amendment, Applicants have cancelled claims 42-47 without prejudice. Also, claims 51-55 are listed as withdrawn from consideration due to Applicants' election. Applicants note that claims 1-41 and 51-55 have been examined.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claim 14 stating that "the payment processor" lacks antecedent basis. Applicants have replaced "the" with --a-- in claim 14. Applicants request the Examiner to withdraw the rejection.

Rejection under 35 U.S.C. § 102(b)

Claims 1-13, 17-30, 33, 35, 37, 39-41, and 51-55 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,721,781 to Deo et al. (hereinafter Deo).

Claim 1 recites a method for activating a subscriber account for providing a network service that comprises:

- receiving initial information from a subscriber;
- storing said received information;
- providing a transaction processing device to said subscriber;
- receiving captured information from said subscriber through said transaction processing device;
- utilizing said captured information to receive verifying information about said subscriber; and
- comparing said verifying information with said initial information to authenticate said subscriber.

Claim 51 recites a method for activating a subscriber account for providing a network service that comprises, in part:

- providing a transaction processing device to said subscriber to provide said network service upon completion of said step of performing due diligence; and
- electronically verifying that an individual activating said subscriber account via said transaction processing device is authorized to activate said subscriber account.

Claim 54 recites a method for activating a subscriber account for providing a network service that comprises:

- providing a transaction processing device to a subscriber, wherein said subscriber provides a network service;
- receiving an application from said subscriber for a subscriber account;
- receiving information from an individual through said transaction processing device to activate said subscriber account; and
- electronically verifying that said individual activating said subscriber account is authorized to activate said subscriber account.

The Examiner asserts that the smart card of Deo is authenticated to perform various functions at a point of sale terminal or ATM. Based upon this assertion, the Examiner concludes that the “providing” limitations of claims 1, 51, and 54 are satisfied by the disclosure of Deo.

Applicants respectfully submit that a “smart card” cannot be fairly considered a “transaction processing device.” Specifically, the smart card merely communicates digital certificates and/or a personal identification number (PIN) with terminal devices such as an automated teller machine (ATM). For example, when a smart card is inserted within an ATM, the smart card communicates a digital certificate to the ATM and the ATM communicates a digital certificate to the smart card. If the digital certificates are correct, further processing may occur. At this point, the actual transaction is processed by the ATM. *See* col. 9, lines 39-47 of Deo. Specifically, Applicants respectfully submit that the ATM transfers funds from the account and provides cash to the user. Thus, the ATM is the transaction processing device and not the smart card.

In regard to claims 1 and 54, information is received through the same transaction processing device provided to the subscriber. In claim 1, the received information is used to receive verifying information about the subscriber. In claim 54, the received information is used to activate the subscriber account. Similarly, in regard to claim 51, the same transaction

processing device provided to the subscriber is used to electronically verify that the individual activating the subscriber account is authorized to activate the subscriber account.

The smart card in Deo does not receive information from a subscriber. Instead, the ATM is used to receive the information from the subscriber and such information is merely passed to the smart card. Additionally, the smart card in Deo does not use the received information to obtain other verifying information or activate an account. It is submitted that the user must have already activated the user's bank account or other account to use the smart card of Deo. Additionally, when the PIN is received by the smart card in Deo, the smart card communicates digital certificates that are related to the smart card and the terminal. However, the digital certificates are not related to the subscriber that has been provided a transaction processing device.

Accordingly, Deo does not disclose each and every limitation of claims 1, 51, and 54. Claims 2-13, 17-30, 33, 35, 37, 39-41, and 52, 53, and 55 respectively depend from base claims 1, 51, and 54 and, hence, inherit all limitations of their base claim. Therefore, Applicants respectfully submit that claims 1-13, 17-30, 33, 35, 37, 39-41, and 51-55 are not anticipated.

Rejections under 35 U.S.C. § 103(a)

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Deo in view of U.S. Patent No. 6,016,476 to Maes et al. (hereinafter Maes).

Claims 31, 32, 34, 36, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Deo in view of U.S. Patent No. 6,233,577 to Ramasubramani et al. (hereinafter Ramasubramani).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicants assert that the rejections do not satisfy these criteria.

The Examiner acknowledges that Deo does not teach or suggest each and every limitation of claims 15, 16, 31, 32, 34, 36 and 38. Accordingly, the Examiner introduces Maes and Ramasubramani to address the deficiency of Deo. However, the combinations, as presented, do not teach or suggest all limitations of these claims. Specifically, claims 15, 16, 31, 32, 34, 36, and 38 depend from base claim 1 and inherit all limitations of claim 1. The combination of references fail to teach or suggest each and every limitation of claim 1.

For the reasons discussed above in regard to the rejection under 35 U.S.C. § 102(b), Deo fails to teach or suggest a transaction processing device provided to a subscriber that satisfies the cooperative limitations of claim 1. Specifically, the smart card of Deo does not transfer funds or perform any other transaction processing. Instead, the ATM performs the transfer of funds. Also, no information is received from the subscriber through a transaction processing device provided to the subscriber. Instead, the subscriber inputs the PIN into the ATM. Furthermore, no verifying information about the subscriber is received to activate the subscriber account.

Maes and Ramasubramani are not relied upon by the Examiner to address the limitations of claim 1. Maes is merely relied upon to disclose a portable processing device. Office Action, page 6. However, there is no teaching or suggestion with Maes that its portable processing device is used in the manner recited by claim 1. Ramasubramani is merely relied upon to disclose wireless communication of a user name and password. Office Action, pages 4-5. Ramasubramani does not teach or suggest a transaction processing device used in the manner recited by claim 1.

Accordingly, the applied references (either alone or in combination) do not teach or suggest each and every limitation of claim 1. Claims 15, 16, 31, 32, 34, 36 and 38 depend from claim 1 and inherit all limitations of claim 1. A prima facie case of obviousness has not been established for claims 15, 16, 31, 32, 34, 36 and 38.

Claims 48-50

Applicants note that claims 48-50 were elected for examination in the response to restriction requirement, dated March 19, 2004. As these claims were elected and have not been rejected, Applicants request that these claims be allowed.

New Claims

Applicants have added new claims 56-61. Claims 56-61 are supported by the original application on, inter alia, pages 14-19 of the application. No new matter has been entered.

Claim 56 recites:

receiving initial information from a subscriber;
storing said initial information;
providing said transaction processing device to said subscriber;
receiving identification information from said subscriber through said transaction processing device;
communicating, by said transaction processing device through a network, said identification information to an authenticating server;
using, by said authenticating server, said identification information to obtain verifying information related to said subscriber; and
activating, by said authenticating server, said subscriber account when said verifying information is consistent with said initial information, wherein said activating enables said transaction processing device to initiate payments into said subscriber account from third parties via said network.

Applicants respectfully submit that the applied references do not teach or suggest each and every limitation of claim 56. For example, the applied references do not teach or suggest providing a transaction processing device to a subscriber and activating a subscriber account by enabling the transaction processing device to initiate payments into the subscriber account from third parties via the network. Additionally, the applied references do not teach or suggest a transaction processing device that communicates with an authentication server in the manner recited by claim 56 to activate the subscriber account.

Accordingly, Applicants submit that claim 56 is patentable over the cited art. Claims 57-61 depend from claim 56 and are submitted to be patentable.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

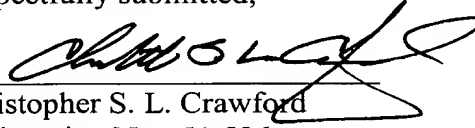
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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 56728/P002US/10005779 from which the undersigned is authorized to draw.

Dated: June 10, 2004

Respectfully submitted,

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